

### **REMARKS**

Claims 18, 21, 36, and 37 are pending and stand rejected.

Applicant has reviewed the Office action, including the Examiner's remarks and the references cited therein. Applicant submits that the following remarks are fully responsive to the Office action, and that all pending claims are patentable over the cited references.

### **Rejection Under 35 U.S.C. § 103**

The Examiner rejects claims 18, 21, 36, and 37 under 35 U.S.C. § 103 as obvious over United States patent no. 5,409,008 ("Svenson") in view of United States patent no. 6,328,699 ("Eigler"). Applicant respectfully disagrees.

Though the prior art references need not teach or suggest each and every limitation of a claim for that claim to be obvious, Applicant contends that the differences between the newly introduced claims and the references cited are sufficiently great so as to render the claimed invention non-obvious to one of ordinary skill in the art at the time the invention was made. MPEP § 2141 ("[T]he focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and on *what such a person would have reasonably expected to have been able to do in view of that knowledge.*") (emphasis added). In particular, Applicant respectfully submits that one of ordinary skill in the art would not have learned the claimed invention from the asserted combination of references without the impermissible use of hindsight in view of the present invention.

The Examiner alleges that "Svenson discloses the claimed invention except for a transseptal needle and sensors of electrophysiological activity of an interatrial septum." Office action, ¶ 8. The Examiner further alleges that Eigler discloses these aspects of the present invention. *Id.* The Examiner concludes that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Svenson's mapping electrodes with Eigler's transseptal needle and puncture system in order to provide a minimally-invasive technique for gathering interatrial septum data for more accurate patient diagnosis." *Id.* at ¶ 9. Applicant respectfully disagrees, and contends

that one of ordinary skill in the art would not have been motivated to modify Svenson in the manner suggested by the Examiner.

Svenson discloses a mapping catheter 10 including a stainless steel support tube 14 surrounded by a polymer sheath 24. Polymer sheath 24 is secured to stainless steel support tube 14 in order to house a plurality of wires 21a-21c therebetween. Svenson, 3:52-4:10; Fig. 2. Because of stainless steel support tube 14, Svenson's mapping catheter 10 is rigid. *E.g., id.* at claim 1. In use, Svenson's mapping catheter is introduced through a thoracotomy (*i.e.*, a surgical incision in the chest wall). Access to a particular chamber of the heart is through a slit in the myocardial wall. *Id.* at 5:28-34.

Eigler, on the other hand, teaches accessing the left atrium of a patient's heart using the Seldinger technique (*i.e.*, through the patient's vasculature). A Brockenbrough catheter and needle are used to puncture the atrial septum in order to access the right atrium from the left atrium. Eigler, 3:46-65.

One of ordinary skill in the art would readily appreciate that Svenson's mapping catheter cannot be introduced vascularly as taught by Eigler. Specifically, because of its rigidity, Svenson's mapping catheter is incapable of navigating the tortuous paths of the patient's vasculature. It follows that one of ordinary skill in the art would not modify Svenson's mapping catheter for transseptal punctures. Instead, to access a cardiac chamber on the opposite side of the heart with the Svenson device, one of ordinary skill would simply introduce Svenson's mapping catheter via a thoracotomy on the patient's opposite side and/or through a separate slit in the myocardial wall. Put simply, one of ordinary skill in the art would not have combined Svenson with Eigler as suggested by the Examiner without the benefit of Applicant's teachings. Such use of hindsight is impermissible. *E.g., W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) ("It is difficult but necessary that the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art.").

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Office action dated April 7, 2009  
Response dated June 3, 2009

Applicant therefore respectfully submits that the Examiner has failed to establish that claims 18, 21, 36, and 37 are *prima facie* obvious. The rejection should be withdrawn accordingly.

**CONCLUSION**

In view of the foregoing remarks, Applicant respectfully submits that the application is in condition for allowance, and requests that all rejections be withdrawn, that all pending claims be allowed, and that the application be passed to issue. If, for any reason, the Examiner finds the application to be in other than condition for allowance, the Examiner is invited to contact the undersigned in an effort to resolve any matter still outstanding before issuing another action.

No extension of time is believed necessary for this paper to be considered timely. Should any extension of time be deemed necessary, Applicant hereby petitions therefor under 37 C.F.R. § 1.136.

Authorization is hereby granted to charge any fees due with the filing of this document, including any fees for any extensions of time deemed necessary, to Deposit Account No. 50-1129 with reference to Attorney Docket No. 0B-052601US/82410-0350.

Respectfully submitted,

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Date: June 3, 2009

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